

REMARKS

Claims 5 and 6 have been amended. Claims 1-3, 5-12, 15-37, 40-50, and 53-59 now remain in the application. The following remarks are respectfully submitted.

Claims 5 and 6 stand rejected under § 112, second paragraph, as being indefinite, as they depend from canceled claim 4. Claims 5 and 6 have been amended such that they now depend from claim 1. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Claims 1-3, 5-12, 15-37, 40-50 and 53-59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0186195 to Comfort (“Comfort”) in view of U.S. Patent No. 882,711 to Pearsall (“Pearsall”). Claims 1, 26 and 47 are the only independent claims of this group.

In regards to the rejection of independent claims 1, 26, and 47, Applicants traverse the rejection. The Examiner admits that Comfort fails to disclose a roller tip (Office Action at p. 2). The Examiner turns to Pearsall as teaching this missing element to arrive at the inventions respectively recited in independent claims 1, 26 and 47 (Office Action at p. 2-3). The Examiner’s asserted combination of Pearsall with Comfort is wrong.

First, there is no motivation to combine these references in the manner asserted by the Examiner. More specifically, the disclosure of Comfort teaches many embodiments for the removable tip member (31), with such embodiments being limited to different shapes of the tip member for carrying out different functions (Comfort at FIGS. 2A-21). The embodiments taught therein are in all cases a non-rotating type. There is no teaching in Comfort of replacing the non-rotating tip member (31) with one of a rotating type, as the embodiments taught therein are used for packing or shaping different materials in the dental and medical applications (e.g., dental materials as well as tissue augmentation). In other words, the device taught in Comfort is intended for uses other than spreading materials onto the surface of teeth. Accordingly, one of ordinary skill in the art would not have a motivation to combine the multi-purpose device of Comfort with the rotating roller tip taught in Pearsall, which is intended for applying foil into teeth by rolling (Pearsall at lines 45-47).

Second, Comfort teaches away from being modified to include the roller tip taught in Pearsall. Comfort teaches that “[t]here are numerous dental and medical instruments . . . [that] are generally designed for specific dental and medical applications” and therefore is concerned with the “unsatisfied need for hand-held medical and dental tools designed for other applications.” (Comfort at para. [0003]). Accordingly, Comfort teaches a hand-held tool for intra-oral use with dental patients and/or for specific medical uses.” These uses include for “the placement and shaping of dental materials . . . [and] . . . the delivery and/or shaping of biomorphic materials used in surgical applications such as bone augmentation” (Comfort at para. [0013]). In sum, Comfort appears to teach a multi-purpose or versatile device, with such versatility being facilitated by the removability of the tip member 31 (Comfort at FIG. 1 and para. [0027]). The roller tip (b) taught in Pearsall relies on a riveted head formed at the end of a stem or handle (a) of the device, to thereby secure the roller tip (b) to the handle (a) (Pearsall at 79-84). In this regard, therefore, the roller tip (b) taught in Pearsall is not removable from the handle (a). Accordingly, one of ordinary skill in the art would not replace the removable tip member (31) of Comfort with the non-removable tip of Pearsall as such replacement would defeat the multi-purpose nature of the device of Comfort that is facilitated by the removability of the tip member (31) thereof.

Comfort further teaches away from being combined with the roller tip (b) of Pearsall in other respects. Comfort relies on a “close, tight fit” or “secure attachment” of the tip (31) to the handle (21) (Comfort at para. [0028] – [0029]). In this regard, such attachment may, for example, be such that the tip (31) may be formed of an elastomeric material having dual durometric elasticity. This would be such that the part of the tip member (31) that fits with the attachment point of the handle (21) is made harder than the distal end portion of the tip member “in order to facilitate secure attachment of the tip member to the end of the handle” (Comfort at para. [0029]). Accordingly, Comfort teaches away from coupling with a tip member such as a roller tip that requires a loose fit or a loose attachment rather than a “close fit” or a “secure attachment” to facilitate rotation thereof.

Third, one of ordinary skill in the art would not have an expectation of success modifying the device taught in Comfort to include the non-removable roller tip (b) taught in Pearsall, even if preserving removability thereof. One of ordinary skill in the art would rather presuppose that the riveted coupling of the roller tip (b) of Pearsall is required for rotation thereof, insofar as rotation of the roller tip (b) during contact with surfaces (e.g. tooth surfaces) would cause the roller tip (b) to decouple from the handle (a) of the device. In this regard, therefore, modification of the tip member (31) of Comfort to include the roller tip (b) of Pearsall would not lead to predictable results, since rotation of the roller tip (b) would be limited or simply not practical in light of the presumed slipping motion thereof during use. Accordingly, one of ordinary skill in the art would not have an expectation of success in modifying the removable tip member (31) of Comfort with the roller tip (b) of Pearsall and such modification would not yield predictable results.

Applicants respectfully submit that the asserted combination of the teachings of Comfort and Pearsall is in error at least for the foregoing reasons and further submit that each of claims 1, 26 and 47 recite a combination of elements not disclosed in the prior art of record. Accordingly, Applicants respectfully request that the rejection of claims 1, 26 and 47 be withdrawn.

Moreover, as each of claims 2-3, 5-12, 15-25, 27-37, 40-46, 48-50, and 53-59 directly or indirectly depends from either of allowable independent claims 1, 26, and 47, and further as each of these claims recites a combination of elements not disclosed in the prior art of record, Applicants respectfully submit that these claims should be allowed as well.

Application No. 10/736,262
Response dated December 6, 2007 to
Office Action mailed July 27, 2007

Conclusion

In view of the foregoing amendments to the claims and remarks given herein, Applicants respectfully believe this case is in condition for allowance and respectfully request allowance of the pending claims. If the Examiner believes any detailed language of the claims requires further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicants are of the opinion that no additional fee is due as a result of this Amendment. Applicants are also of the opinion that a two-month extension of time is due with this Amendment. Payment of all charges due for this filing is made on the attached Electronic Fee Sheet. If any additional charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS LLP.

By: /Kristi L. Davidson/
Kristi L. Davidson, Reg. No. 44,643

2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202
513/241-2324 (voice)
513/241-6234 (facsimile)
403734_1.doc